

Remarks:

Reconsideration of the application is respectfully requested.

Claims 1 - 14 are presently pending in the application. Claim 1 has been amended to even more clearly set forth the antecedent basis for one of the limitations. As it is believed that the claims were patentable over the cited art in their previously presented form, the claims have not been amended to overcome the references.

In item 1 of the final Office Action dated July 23, 2004 (the "**final Office Action**"), claim 1 was objected to as allegedly being indefinite under 35 U.S.C. § 112, second paragraph for reciting "the message", instead of "the new message".

Applicants respectfully traverse the above rejection. In light of Applicants' the arguments to the contrary made in the Appeal Brief, which arguments are being incorporated herein by reference, and in view of the Board's Decision on Appeal on this issue, "the message" of Applicant's claim 1 is believed to be definite under 35 U.S.C. § 112, second paragraph.

Also in item 1 of the **final Office Action**, Applicants' claim 1 was rejected under 35 U.S.C. § 112, second paragraph for allegedly failing to provide antecedent basis for "the subscriber". Applicants have amended claim 1 to address the

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concern raised regarding "the subscriber" in item 1 of the
final Office Action.

In view of the foregoing, Applicants' claims are believed to
be definite under 35 U.S.C. § 112, second paragraph.

In item 3 of the Office Action, claims 1 - 12 were rejected
under 35 U.S.C. § 102(b) as allegedly being anticipated by U.
S. Patent No. 6,333,973 to Smith et al ("**SMITH**"). Claims 13 -
14 were rejected under 35 U.S.C. § 102(b) as allegedly being
anticipated by **SMITH**, in the Supplemental Examiner's Answer
mailed on July 24, 2006.

Applicants respectfully traverse the above rejections.

First, Applicants reserve the right to introduce further
evidence, at a later date, showing conception of the present
invention and/or reduction to practice prior to the effective
date of the **SMITH** reference.

Additionally, claim 1 recites, among other limitations:

selecting, by the subscriber, at least one terminal
from a plurality of terminals of the message services;
and

transmitting a notification, with the notification
**server, to the at least one selected terminal, in
contrast to transmitting the message, the transmitted**

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notification indicating that a new message is present and in which message service the new message is present. [emphasis added by Applicants]

As such, Applicants' claims require, among other limitations, that the subscriber selects at least one terminal from a plurality of terminals of the message services to which the notification server transmits a notification, in contrast to transmitting the message. This feature of Applicants' invention is discussed, for example, on page 14 of the instant application, line 12 - page 15, line 2, which states:

In a further alternative embodiment, the notification is not transmitted to all the terminals of the subscriber but rather just to one terminal or to some of these terminals. The selection of the terminals can be carried out centrally, for example by means of a system administrator. However, it is also possible for the subscriber to make the selection himself. To do this, the subscriber can transmit a suitable control information item to the notification server from one of his terminals. The control information item can include the addresses (for example telephone numbers) of those terminals to which the notifications are to be directed. As an alternative, it is possible to provide for the notification server MWIS to direct future messages only to the terminal, or also to the terminal, from which the last received control information item originates. The subscriber can then register a terminal as a notification receiver by means of a simple selection of the notification server. [emphasis added by Applicants]

However, the **SMITH** reference fails to teach or suggest, among other limitations of Applicants' claims, that the subscriber selects at least one terminal from a plurality of terminals of the message services to which the notification server

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transmits a notification, in contrast to transmitting the message. Rather, the SMITH reference discloses only one terminal that can receive the notifications of the message (i.e., the mobile phone 1100 of SMITH), and that single terminal is not selected by the subscriber. This can be seen, for example, from col. 3 of SMITH, lines 50 - 54, cited in the final Office Action, which state:

The integrated message center is a logical entity that resides in mobile telephone 1100 and operates in conjunction with network services provider 1200 to inform a user of incoming and pending messages, such as fax mail, e-mail, voice mail, etc. [emphasis added by Applicants]

As such, the integrated message center of the SMITH reference resides in the mobile telephone 1100 of SMITH. Further, col. 3 of SMITH, lines 60 - 67, state:

The user uses mobile telephone 1100 to view messages from callers having different types of caller equipment, such as ordinary telephone 1300, caller mobile telephone 1400 which is similar to user mobile telephone 1100, facsimile equipment 1500, computer 1600, and Analog Display Services Interface (ADSI) telephone 1700. The callers leave different types of messages for the user, depending upon the type of caller equipment. [emphasis added by Applicants]

As such, in the SMITH reference the notification of a received message is provided to the mobile telephone 1100 of SMITH, which is not selected by the subscriber from a plurality of terminals, as required by Applicants' claims.

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Page 3 of the **final Office Action** pointed to Figs. 7A, 7B and 11 of **SMITH** as allegedly disclosing "a plurality of terminals of messages [sic] services is shown on the phone". Applicants respectfully disagree that these figures teach or suggest, among other limitations of Applicants' claims, **selecting, by the subscriber, at least one terminal from a plurality of terminals of the message services, wherein the notification server transmits a notification, to the at least one selected terminal, in contrast to transmitting the message.**

First, col. 8 of **SMITH**, lines 36 - 45 and col. 9, lines 3 - 5, state:

FIG. 7A is an example display in which message center 6100 presents the user with an indication of the total number of messages received 7100 and sent 7200, **and a scrollable, selectable list 7300 of notification headers for all the received messages. Each entry in the scrollable list of notification headers identifies a received message and includes the sender's name 7400 and an identification icon 7500, identifying the type of message.** The identification icons include, for example, icons used to identify voice mail, SMS messages, e-mail, and faxes.

. . . .

FIG. 7B, message center 6100 uses a check mark 7600 to indicate that a message has been read or heard.
[emphasis added by Applicants]

As such, Figs. 7A and 7B of **SMITH** merely show an example display of the message center on the phone 1100, including a **scrollable, selectable list 7300 of notification headers for**

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all the received messages, each received message entry including an identification icon 7500, identifying the type of message. As such, the list of terminal types shown in Figs. 7A and 7B are not terminals selectable by the subscriber from a plurality of terminals. The subscriber cannot select the actual terminals shown in Figs. 7A and 7B of **SMITH**, as required by Applicants' claims, because these icons merely represent the sender's terminal type. Nor will the selection of a message including an icon representing the type of message in Figs. 7A and 7B of **SMITH**, cause a notification server to transmit a notification to the at least one selected terminal, in contrast to transmitting the message. Rather, in **SMITH**, the selected message represented by the icon is displayed on the subscriber's phone 1100, which is not a terminal selected by the subscriber. As such, Figs. 7A and 7B of **SMITH** do not teach or suggest, among other limitations of Applicants' claims, selecting, by the subscriber, at least one terminal from a plurality of terminals of the message services, wherein the notification server transmits a notification, to the at least one selected terminal, in contrast to transmitting the message. Rather, selection of one of the items in the lists of Figs. 7A and 7B, causes the message to be transmitted by the server to the phone 1100, and not the notification. This can be seen, for example, from col. 10 of **SMITH**, lines 48 - 56, which state:

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When the user wants to retrieve the e-mail message after viewing the e-mail notification message, **the user first selects the e-mail icon corresponding to the e-mail message from the message center display (FIGS. 7A and 7B),** and then instructs mobile telephone 1100 **to retrieve the e-mail message** by pressing the "View" button. In response, mobile telephone 1100 establishes a connection with network services provider 1200 **to download the e-mail message** from e-mail server 5800. [emphasis added by Applicants]

Similarly, Fig. 11 of **SMITH** also fails to teach or suggest, among other limitations of Applicants' claims, **selecting, by the subscriber, at least one terminal from a plurality of terminals of the message services, wherein the notification server transmits a notification to the at least one selected terminal, in contrast to transmitting the message.** This can be seen from col. 10 of **SMITH**, lines 3 - 29, which state:

FIG. 11 is an example of a screen display in which the user wants to retrieve a fax, or fax mail message, from a caller using facsimile equipment 1500 (FIG. 1). Message center 6100 provides a graphical depiction of the SMS fax notification message that mobile telephone 1100 received from network services provider 1200. At this point, however, fax mail server 5700 in network services provider 1200 continues to store the actual contents of the fax.

Message center 6100 permits the user to view the fax notification message, select and view the contents or a portion of the contents of the fax, forward the fax to facsimile equipment, a printer, or a computer, delete the fax, and change the password to fax mail server 5700. FIG. 11 shows that message center 6100 provides the user with graphical controls corresponding to these features.

When the user wants to retrieve the fax after viewing the fax notification message, the user first selects

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the fax icon corresponding to the fax from the message center display (FIGS. 7A and 7B), and then instructs mobile telephone 1100 to retrieve the fax by pressing the "View" button. In response, mobile telephone 1100 establishes a B-channel connection with network services provider 1200 to download the fax from fax mail server 5700. Display 2400 only displays a portion of the downloaded fax at a time due to display 2400's limited size. Mobile telephone 1100 provides on-screen graphical scroll keys, or hard keys on main housing 2100, to allow the user to scroll horizontally and vertically to view the entire fax. [emphasis added by Applicants]

As can be seen from the foregoing, like the lists of Figs. 7A and 7B of **SMITH**, Fig. 11 of **SMITH** merely shows a list of fax notifications, the selection of which retrieves the actual fax for review on the phone 1100 of SMITH, or for transfer to a fax machine. It is important to note that the selection of a fax machine for transfer from the list in Fig. 11 of **SMITH** does not cause a notification server to transmit a notification, to the selected device, in contrast to transmitting the message, as required by Applicants' claims. Rather, selection of a fax machine from the list of Fig. 11 causes the actual message to be sent to the selected device, without the transmission of the fax notification. This can be seen from col. 10 of **SMITH**, lines 30 - 37, which state:

When the user wants to forward the fax after viewing the fax notification message, the user first selects the fax icon from the message center display, and then presses the graphical button corresponding to the destination location. In response, mobile telephone 1100 establishes a connection with network services provider 1200 and informs fax mail server 5700 where to forward the fax. [emphasis added by Applicants]

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Thus, it can be seen that the **SMITH** reference fails to teach or suggest, among other limitations of Applicants' claims, selecting, by the subscriber, at least one terminal from a plurality of terminals of the message services, wherein the notification server transmits a notification to the at least one selected terminal, in contrast to transmitting the message. For the foregoing reasons, among others, Applicants' claims are believed to be patentable over the **SMITH** reference.

It is accordingly believed that none of the references, whether taken alone or in any combination, teach or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1.

In view of the foregoing, reconsideration and allowance of claims 1 - 14 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

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If an extension of time for this paper is required, petition
for extension is herewith made.

Please charge any fees that might be due with respect to
Sections 1.16 and 1.17 to the Deposit Account of Lerner
Greenberg Sterner LLP, No. 12-1099.

Respectfully submitted,



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